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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,427	11/20/2003	Takashi Tatsumi	245637US0	6969
22850	7590	10/12/2007	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			NAGUBANDI, LALITHA	
		ART UNIT	PAPER NUMBER	
		1621		
		NOTIFICATION DATE	DELIVERY MODE	
		10/12/2007	ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

[patentdocket@oblon.com](mailto:patentdocket@oblon.com)  
[oblonpat@oblon.com](mailto:oblonpat@oblon.com)  
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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/716,427	TATSUMI ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Lalitha Nagubandi	1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 23 July 2007.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.  
 4a) Of the above claim(s) 1-7 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 8-15 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Detailed Office Action***

***Status of Claims***

Claims 1-15 are pending. Claims 8-15 are considered for examination in this office action.

***Response to Argument***

Applicants' remarks, filed on June 23<sup>rd</sup>, 2007, with respect to the previous office action dated March 23<sup>rd</sup>, 2007 have been fully considered.

The arguments made with respect to Claims 8 under 102 (b) rejection and further in view of the amendment, the 102(b) rejection made in the previous office action dated March 16<sup>th</sup> 2007 has been withdrawn.

The arguments made with respect to claims 8-15 under 103 (a) rejection is not found persuasive for the following reasons:

1. Applicants' assert that "the criticality of the combination of the anionic surfactant in conjunction with a basic silane of formula (1) is demonstrated in table 1 (see comparison of Examples 6-12 to Comparative Example 4) Example 13 further illustrates the criticality of this combination" ----

This argument is not found persuasive because all the examples in the Table 1 of the specification are directed to the combination of (A) an anionic surfactant (B) silicate monomer (C) basic silane. There is no example in the table, which is directed to the combination of: (1) cationic surfactant (2) silicate monomer (3) basic silane, is shown.

It is the examiner's position that in the absence of a comparative showing of the cationic and anionic surfactant clearly showing unexpected results the claims are *prima facie* obvious.

Moreover, examiner directs the attention of the applicant to the comparative example 2, where, when the anionic surfactant is used, no complex formation was observed. This suggests that the mole ratios of components A, B and C are critical and therefore should be incorporated into the claims.

**2.** Applicant's argue "Brinker et al suggest anionic surfactant, fails to disclose how the skilled artisan can use an anionic surfactant in such a way to solve the problems that plagued such a method".

This argument is not found persuasive because US Pat. No. 585,457, generally suggests that the anionic surfactant would work when replacing the cationic surfactant. There is no requirement that the prior art suggest solving a problem when this is not a limitation of the claims.

For the reasons cited above the **103** (a) rejection under 35 USC made in our earlier office action is thus maintained.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-15 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Hall et al, (Chem. Commun., 1999, pages 201 –202) and in view of Brinker et al (US Patent No. 5,858,457 dt. Jan 12<sup>th</sup>, 1999).

***Conclusion***

No claims are allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalitha Nagubandi whose telephone number is 571 272 7996.

The examiner can normally be reached on 6.30am to 3.00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Yvonne, Eyler** can be reached on 571 272 0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lalitha Nagubandi  
Patent Examiner  
Technology Center 1600

October 2<sup>nd</sup>, 2007.



Samuel A Barts

Primary Patent Examiner  
Technology Center 1600